

REMARKS

The Amendments

The claims are replaced with new claims in order to direct the invention to the elected invention pursuant to the restriction requirement, and particularly to an aspect of the elected invention which has been indicated to be allowable. Further, the "hydroxy" definition for R¹⁷ is eliminated in view of the cited prior art. Support for the subgenus of applicants' invention wherein R¹⁷ is not hydroxy is supported by the fact that, of the multiple specific compounds disclosed in the specification, none are 17-hydroxy compounds.

The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application. To the extent that the amendments avoid the prior art, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction Requirement

The restriction requirement is believed to be rendered at least partially moot by the claim amendments directing the invention to the elected species, i.e., compounds wherein the dotted lines do not indicate any double bonds.

As to the method of use claims (now claims 66-89), it is respectfully submitted that, since the compound claims are allowable and the methods pertain to compounds of the same scope (i.e., they are dependent claims), the method claims should be rejoined with the compound claims and allowed to issue in the same patent. It should be noted that the method

claims pertain to one generic method concept (see claim 66) from which all the other method claims are dependent. The rejoinder of the method claims is proper and in accordance with the law set forth in In re Ochiai, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995); and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also the Commissioner's notice thereon dated February 28, 1996, printed in 1184 OG 86, wherein it was stated that non-elected process claims which depend from or otherwise include the limitations of allowed product claims will be rejoined and included in the examination of the application upon allowance of the product claims.

The Rejections under 35 U.S.C. §102

The rejections of claims under 35 U.S.C. §102, as being anticipated by Siebert (Abstract 110:75884) or Anner (Abstract 79:137384), are respectfully traversed.

The definition of R¹⁷ in the instant claims is amended to exclude the term "hydroxy." Thus, the compounds of the prior art references do not provide any embodiment within the scope of the instant claims. The compounds of the references each require hydroxy at the 17-position corresponding to R¹⁷ of applicants' formula (I). In fact, the hydroxy substitution in the 17-position appears to be an important structural requirement in the reference compounds. Accordingly, neither reference anticipates the instant claims and the rejections under 35 U.S.C. §102 should be withdrawn.

The Rejections under 35 U.S.C. §103

The rejections of claims under 35 U.S.C. §103, as being obvious over Siebert or Anner, are respectfully traversed.

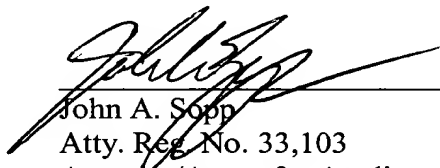
The Siebert and Anner references are discussed above and that discussion is incorporated herein by reference. As noted above, the Siebert and Anner compounds require

a 17-position hydroxy group as an important aspect of their compounds. There is no suggestion in either reference to modify the compounds to remove the hydroxy group from the 17-position. To the contrary, it would appear that removal of the 17-hydroxy group would be contrary to the references' teachings and objectives. Thus, rather than motivating one of ordinary skill in the art to make such a modification, the prior art de-motivates or teaches away from such a modification. In this situation, the references cannot render the claimed invention obvious to one of ordinary skill in the art. Thus, the rejections under 35 U.S.C. §103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: **SCH-1692**

Date: June 18, 2002